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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,848	02/05/2004	John M. Barrie	IPARA-08769	5758
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Casimir Jones, S.C. 440 Science Drive Suite 203 Madison, WI 53711				
EXAMINER				
VAUGHN, GREGORY J				
ART UNIT		PAPER NUMBER		
2178				
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04/15/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/772,848

Applicant(s)

BARRIE ET AL.

Examiner

GREGORY J. VAUGHN

Art Unit

2178

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1.5-10, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1.5-10, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date 2/10/2009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Action Background

1. This action is responsive to the Request for Continued Examination filed on 2/3/2009.
2. Applicant has amended claims 1 and 7 and added claims 14 and 15. Claims 2-4 and 11-13 were previously canceled.
3. Claims 1, 5-10, 14 and 15 are pending in the case; claims 1 and 7 are independent claims.
4. A request for continued examination filed under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after a final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action (dated 10/6/2008) has been withdrawn pursuant to 37 CFR 1.114.
5. The rejection of claims 1 and 5-10, rejected as described in the office action dated 10/6/2008, is withdrawn in view of the amended claims; however, new grounds of rejection are made, as described below.

Priority

6. As previously noted, applicant's claim for domestic priority under 35 U.S.C. 119(e) of US provisional application 60/447,379, filed 2/13/2003 is acknowledged.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanahan et al. US Patent Publication 2005/0022114, filed 12/5/2001, published 1/27/2005 (hereinafter Shanahan) in view of Sragner, US patent 6,272,485, patented 8/7/2001.
9. **Regarding independent claims 1 and 7**, Shanahan discloses receiving a document over an electronic communication network. Shanahan recites: *"In one operational embodiment, multifunctional (i.e., fax, scan, print, store, email) device 512 scans in a document 614"* (paragraph 179). Shanahan discloses the

multifunctional device 512 as part of an electronic communication network in Figure 5, reference sign 516 (shown as "Intranet"). Shanahan discloses converting the formatted document into a standardized formatted document. Shanahan recites: *"document content is detected and converted to a digital form"* (paragraph 179). Shanahan discloses permitting a user to add contextual markups to the formatted document to generate a markup document. Shanahan recites: *"Annotate" is used herein to mean to create a reference between an entity in a document, or region of a document, and some set of links, text segment, images, or embedded data"* (paragraph 117) and *"Document "mark-up" is used herein to mean the annotation applied to a document"* (paragraph 120). Shanahan discloses displaying the mark-up document. Shanahan recites: *"a visualization and interaction system that allows various levels of display and interaction of metadata-enhanced documents"* (paragraph 146).

Shanahan discloses adding contextual markups (described as annotate), as described above. Shanahan discloses user added annotations in a variety of forms, including *"text segments"*, as described above. Shanahan fails to explicitly describe the annotations as editorial comments, corrections, annotations, symbols or comments added by a user, however, editorial comments, corrections, annotations, symbols and comments are all text segments, and a user could use the text segment to contain editorial comments, corrections, annotations, symbols and comments. Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made to use the annotation text segments, as taught

by Shanahan for editorial comments, corrections, annotations, symbols and comments in order *"to enrich the documents while facilitating reading comprehension, understanding relationships with other documents, and content creation"* (Shanahan, paragraph 3).

Shanahan discloses the standardized document as an image file. Shanahan recites: *"A 'document' is used herein to mean an electronic (e.g., digital) or physical (e.g., paper) recording of information. In its electronic form, a document may include image data, audio data, or video data. Image data may include text, graphics, or bitmaps"* (paragraph 119) and *"continuous-education document service request. For example, a textbook document"* (paragraph 145).

Shanahan discloses the contextual markups are added to an invisible image that maps to said image file. Shanahan recites: *"A meta-document 100, for example, may be given a personality 104 that is: ... (c) private: marked to keep the document's metadata invisible to other documents"* (paragraph 149).

Shanahan fails to disclose the received document as a grant application. Sragner discloses that grant applications are electronic documents. Sragner recites: *"private corporate hosts providing selectable documents and services from a central server such as tax forms, application forms such grant applications, business and tax forms and reporting forms, and publications such as government reports, books, and instructions"* (column 3, lines 37-41).

Therefore it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to use Shanahan's document system with grant

applications, as taught by Sragner "in order to simplify the user tasks of retrieving and working with documents and data relating to retrieved documents" (Sragner, column 1, lines 11-14).

10. **Regarding dependent claim 5**, Shanahan discloses storing information related to the document in a database. Shanahan recites: *"FIG. 45 is a flow diagram for creating and updating an entity database dynamically from the document information space"* (paragraph 59).
11. **Regarding dependent claim 6**, Shanahan discloses the information consisting of an identifier of a submitter. Shanahan recites: *"this invention relates to the use of a digitally readable personality identifier in a meta-document management system"* (paragraph 3).
12. **Regarding dependent claims 8 and 9**, Shanahan discloses the standardized document as an image file (claims 2 and 11) as a manuscript (claim 8) and an educational assignment (claim 9). Shanahan recites: *"A "document" is used herein to mean an electronic (e.g., digital) or physical (e.g., paper) recording of information. In its electronic form, a document may include image data, audio data, or video data. Image data may include text, graphics, or bitmaps"* (paragraph 119) and *"continuous-education document service request. For example, a textbook document"* (paragraph 145).
13. **Regarding dependent claim 10**, Shanahan discloses the Internet in Figure 2 at reference sign 221.

14. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanahan in view of Sragner, in further view of Banerjee et al., US Patent Publication 2004/0205130, filed 9/27/2001, published 10/14/2004 (hereinafter Banerjee).
15. Regarding claims 14 and 15, Shanahan and Sragner fail to disclose an instructor or a peer reviewer adding the contextual markups to the documents. Banerjee discloses a lecture preview invention that allows an instructor and student peers to review a lecture document and add comments or questions. See for instance Figure 5, where an interface is shown that allows for the user to enter notes. Therefore it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine a system for instructors and peers, as taught by Banerjee with the management of documents and their annotations, as taught by Shanahan and Sragner in order to provide *"data processing system for an interactive online discussion of lecture notes"* (Banerjee, paragraph 2).

Response to Arguments

16. Applicant's arguments with respect to claims 1 and 5-10 have been considered but are moot in view of the new ground(s) of rejection, as described above.
17. Applicant argues that *"The Examiner has provided no evidence that Shanahan teaches or contemplates adding invisible image layers to an image file"* (page last paragraph of the first page of remarks, of the response filed 2/10/2009). In response

to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*invisible image layers*") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Stephen S. Hong/
Supervisory Patent Examiner, Art
Unit 2178

/Gregory J. Vaughn/
Patent Examiner
April 13, 2009